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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/713,169	11/13/2003	Bruce D. Williams	13-97	9814

757 BRINKS HOFER GILSON & LIONE P.O. BOX 10395 CHICAGO, IL 60610	7590 03/22/2007
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EXAMINER FERGUSON, LAWRENCE D	
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ART UNIT 1774	PAPER NUMBER
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SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/22/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/713,169

Applicant(s)

WILLIAMS ET AL.

Examiner

Lawrence D. Ferguson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-16 and 18-24 is/are rejected.
- 7) ☒ Claim(s) 17 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This action is in response to the provisional election mailed December 22, 2006.

Claims 11 was amended rendering claims 11-24 pending.

Claim Rejections – 35 USC 112, first paragraph

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 11-24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Neither the instant claims or specification teaches how much starch content is in non-currency grade paper, which makes it difficult to determine a lower starch amount in the first material, when comparing it to that of non-currency grade paper, as claimed.

Claim Rejections – 35 USC 112, second paragraph

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 11-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In instant claim 11, it is unclear how much starch content is in the non-currency grade paper.

Claim Rejections – 35 USC § 102(b)

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 11-16 and 18-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Collings (U.S. 5,188,871).

Collings discloses verifying the authenticity of a coupon or paper by incorporating a chemical reagent in the paper which on being contacted by an authenticating composition will produce a characteristic colour change (column 1, lines 13-26 and 51-61) where starch is incorporated and the authenticating composition is an acidic

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solution, where the reaction creates a dark colouration (column 2, lines 31-44). Collings additionally discloses the starch may be applied by a coating or printing technique, where the printing may be in the form of a pattern (column 4, lines 61-68). The verification of the authenticity of the paper can be done using pens (column 5, lines 7-16) which would result in only a portion that is marked with the pen to be reacted. Because there is no teaching of the starch content in non-currency grade paper, it is difficult to determine a lower starch amount in the first material, when comparing it to that of non-currency grade paper, as claimed.

Claim Rejections – 35 USC § 102(b)

8. Claims 11-14 and 16, 18-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Ahlm, Jr. et al (U.S. 3,001,887).

Ahlm, Jr. discloses verifying the authenticity of a coupon having a surface printed with an indistinguishable material which will form initially colorless and inherently authenticating words, symbols or designs adapted to be developed in color upon the application of certain chemical agents (column 1, lines 9-45 and 55-65). The Figure of Ahlm, Jr. shows a large portion of the coupon avoiding a reaction with the chemical and not undergoing a color change for the authentic coupon and another portion undergoing the reaction to produce a color change to a darker color than the paper. Because Ahlm, Jr. is silent of starch, it is a good ascertain that the coupon is free of starch, rendering it to have a lower starch content than non-currency grade paper.

Claim Rejections – 35 USC § 103(a)

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Collings (U.S. 5,188,871) in view Kurrle (U.S. 6,214,766).

Collings is relied upon for instant claims 11, 20 and 21. Collings does not explicitly disclose the printing process for applying the coated material to be a flexo device. Kurrle teaches a paper product made to be authenticatable by the application of a printed image containing starch applied to the paper product and where a solution added to the surface of the paper produces an instantaneous blue or black color (column 3, lines 20-31) where the coated printed material can be applied using a flexography printing process. Collings and Kurrle are both directed to verifying the authenticity of a paper product. It would have been obvious to one of ordinary skill in the art to have applied the coated printed material using flexography, as taught in Kurrle, in the paper or coupon of Collings to produce an improved layer of material on the surface of the paper, which will not readily come off the surface.

Claim Rejections – 35 USC § 103(a)

11. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ahlm, Jr. et al (U.S. 3,001,887) in view Kurrle (U.S. 6,214,766).

Ahlm, Jr. is relied upon for instant claims 11, 20 and 21. Ahlm, Jr. does not explicitly disclose the printing process for applying the coated material to be a flexo device. Kurrle teaches a paper product made to be authenticatable by the application of a printed image containing starch applied to the paper product and where a solution added to the surface of the paper produces an instantaneous blue or black color (column 3, lines 20-31) where the coated printed material can be applied using a flexography printing process. Ahlm, Jr. and Kurrle are both directed to verifying the authenticity of a paper product. It would have been obvious to one of ordinary skill in the art to have applied to coated printed material using flexography, as taught in Kurrle, in the paper or coupon of Ahlm, Jr. to produce an improved layer of material on the surface of the paper, which will not readily come off the surface.

12. Claim 17 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, first paragraph and second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

The closest prior art does not teach or suggest the recited method further including determining that the coupon is authentic when a light mark results from applying a chemical to the coupon and not authentic when a dark mark results from

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applying a chemical to the coupon. The prior art does not teach motivation or suggestion for modification to make the invention as instantly claimed.

Response to Arguments

13. Applicant's arguments of the claims rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement have been considered but are unpersuasive. Applicant states the cited reference 6,214,766 notes the common use of starch in paper and the cited reference 5,063,163 notes the differences in starch content for different types of paper. Applicant further states based upon the document attached in Appendix A, titled What You Need to Know About Starch in Papermaking, one skilled in the art should know how much starch content is in non-currency paper.

Applicant's arguments are well taken; however, it remains unclear as to how much starch content is found in non-currency grade paper. This information is essential in determining how much starch content is found in the first material, based upon instant claim 11. Applicant has not convincingly taught what is a known amount of starch content in non-currency grade paper within the art. No clear support of a starch content value can be determined from Applicant's arguments. Applicant states an absolute amount of starch is not claimed, only a relative amount. Neither an absolute nor a relative amount of starch content has been claimed by Applicant within the instantly claimed invention. Therefore, Examiner maintains that because there is no teaching of the starch content in non-currency grade paper, it is difficult to determine a lower starch amount in the first material, when comparing it to that of non-currency grade paper, as

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claimed. As a result, the rejection made under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement is maintained for reasons of record.

Applicant's arguments of the claims rejected under 35 U.S.C. 112, second paragraph, have been considered but are unpersuasive. Applicant argues claim 11 recites a comparative starch content, not an absolute content; therefore, claims 11-24 point out the claimed subject matter. Although Applicant does compare starch content of a first material with that of non-currency grade paper, it remains unclear as to how much starch content is found in non-currency grade paper. This information is essential in determining how much starch content is found in the first material, based upon instant claim 11. No amount of starch content has been claimed by Applicant within the instantly claimed invention. Therefore, Examiner maintains that because there is no teaching of the starch content in non-currency grade paper, it is difficult to determine a lower starch amount in the first material, when comparing it to that of non-currency grade paper, as claimed. As a result, the rejection made under 35 U.S.C. 112, second paragraph, is maintained for reasons of record.

Applicants arguments to the rejection made under 35 U.S.C. 102(b) as being anticipated by Collings (U.S. 5,188,871) has been considered but is unpersuasive. Applicant argues Collings fails to disclose or suggest providing a first material having a lower starch content than non-currency grade paper forming the coupon. No amount of starch content has been claimed by Applicant within the instantly claimed invention. Therefore, Examiner maintains that because there is no teaching of the starch content

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in non-currency grade paper, it is difficult to determine a lower starch amount in the first material, when comparing it to that of non-currency grade paper, as claimed.

Applicant further argues Collings fails to teach a first material. Collings discloses a coating or printing technique, where the printing may be in the form of a pattern (column 4, lines 61-68) where the coating or print is the first material. Applicant maintains that no material with a lesser starch content is provided on or within the paper. Examiner maintains that because there is no teaching of the starch content in non-currency grade paper, it is difficult to determine a lower starch amount in the first material, when comparing it to that of non-currency grade paper, as claimed. Applicant argues Collings fails to teach a coating. Collings discloses applying a coating or printing technique (column 4, lines 61-68).

Applicants arguments to the rejection made under 35 U.S.C. 102(b) as being anticipated by Ahlm, Jr. et al (U.S. 3,001,887) has been considered but is unpersuasive. Applicant argues Ahlm, Jr. fails to disclose or suggest providing a first material having a lower starch content than non-currency grade paper forming the coupon. Because Ahlm, Jr. is silent of starch, it is a good ascertain that the coupon is free of starch, rendering it to have a lower starch content than non-currency grade paper.

Applicants arguments to the rejection made under 35 U.S.C. 103(a) as being unpatentable over Collings (U.S. 5,188,871) in view Kurrle (U.S. 6,214,766) has been considered but is unpersuasive. Because Applicant has not specifically argued why the combination is not obvious over the art, the rejection is maintained for reasons of record.

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Applicants arguments to the rejection made under 35 U.S.C. 103(a) as being unpatentable over Ahlm, Jr. et al (U.S. 3,001,887) in view Kurrle (U.S. 6,214,766) has been considered but is unpersuasive. Because Applicant has not specifically argued why the combination is not obvious over the art, the rejection is maintained for reasons of record.

14. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is 571-

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272-1522. The examiner can normally be reached on Monday through Friday 9:00 AM – 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye, can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



L. Ferguson
Patent Examiner
AU 1774



RENA DYE
SUPERVISORY PATENT EXAMINER

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